11. (Amended) A method of testing the operation of a modem in a computer using a modem testing device, the method comprising:

coupling the modem in the computer to the modem testing device;

coupling the computer to the modem testing device via an alternate communication link;

initiating transmission of test data from the modem by sending a signal from the modem testing device over the alternate communication link;

receiving the transmission from the modem at the modem testing device;

verifying the transmission;

initiating transmission of test data from the modem testing device;

receiving the transmission from the modem testing device at the modem; and

verifying the transmission.

REMARKS

After entry of the foregoing amendments, claims 1, 3-5, 8, 10 and 11 are pending in the application and are presented for reconsideration and further examination. By the foregoing amendments, claims 2, 6, 7, 9 and 10 have been cancelled without prejudice or disclaimer and claims 1, 5, 8 and 11 have been amended.

The specific changes to the amended claims are shown on a separate set of pages attached hereto and entitled **VERSION WITH MARKINGS TO SHOW CHANGES MADE**, which follows the signature page of this Amendment. On this set of pages, the insertions are underlined while the **[deletions are bolded and enclosed within brackets]**.

Applicant thanks the Examiner for the courtesy extended during the telephone interview conducted with the undersigned on December 23, 2002. During that interview, an overview of the amendments made in this response were discussed along with an overview of the following remarks.

Rejections under § 102

In the Office Action, all of the pending claims were rejected under 35 U.S.C. § 102(e) as being anticipated by Simmons et al. (U.S. Patent No. 6,195,414). Applicant respectfully submits that the amended claims are patentable over the references of record. Though the following remarks are primarily directed to the independent claims, they apply with equal force to each of the claims which depend therefrom.

Simmons is generally directed to an apparatus and methods for simulating a digital facility, including impairments, in a public switched telephone network. (Simmons, Abstract). Simmons appears to be addressing the issue of providing telephone network simulation equipment while addressing the variability in the performance of CODECs.

Amended claim 1 is directed to a device for testing the operation of a modem in a computer. Simmons does not teach or suggest testing the operation of a modem in a computer. The device of claim 1 further comprises a first communication port configured to be directly coupled to a modem in the computer and a second communication port configured to be coupled with the computer to form a secondary communication link. A signal reporting circuit located within the case includes a microprocessor which sends a signal to the computer via the secondary communication link to initiate the transmission of test data from the modem in the computer via the primary communication link. This allows the signal reporting circuit to evaluate the transmit capability of the modem in the computer.

The first communication port is attached directly to the modem in the computer and thereby does not provide any simulation of a public switch telephone network as does Simmons. In addition, Simmons does not teach or suggest such a device which has a first communication port directly attached to the modem in the computer and a second communication port also coupled to the computer. For example, the computer in Simmons (Figure 1A, PC180) does not appear to be directly coupled to the network simulator 100 in any manner. It appears to only have an RS232 connection 175 to the modem under test 170. Therefore, Simmons appears to completely lack the first communication port and the second communication port as defined in claim 1, in combination with the other elements thereof.

Independent claim 5 is directed to a method of testing the operation of a modem in the computer using a portable modem testing device. The method includes, *inter alia*, coupling the modem in the computer to the portable modem testing device and coupling the computer to the portable modem testing device via an alternate communication link. A signal from the portable modem testing device is sent to the computer via the alternate communication link to initiate testing the operation of the modem. The modem in the computer then transmits to the portable modem testing device. That transmission is then verified. Again, that is unlike the Simmons reference which does not have two communication paths, one for the modem in the computer and one alternate path to the computer. Again, as with claim 1, Simmons does not appear to teach or suggest coupling the modem in the computer to the portable testing device and coupling the computer to the portable testing device via an alternate communication link.

Similarly, claim 8 is also directed to a method of testing the operation of a modem in the computer using a modem testing device. The method includes coupling the testing device to both the modem in the computer and to the computer via an alternate communication link. Simmons does not appear to teach or suggest coupling a testing device to both the modem in the computer and via an alternate communication link to the computer. Additionally, the method includes sending a signal to the computer via the alternate communication link to initialize the modem. Again, no such step, in combination with the other steps, appears to be taught or suggested by Simmons. The testing device then transmits test data to the modem and verifies the transmission. Additionally, the modem transmits test data to the modem testing device.

Finally, claim 11 is also directed to a method of testing the operation of a modem. Again, the claimed method includes coupling the testing device both to the computer via an alternate communication link and to the modem in the computer. The test is initialized by sending a signal from the testing device over the alternate communication link to the computer. Transmissions are sent to and from the modem in the computer. No such method appears to be taught or suggested by Simmons.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that the pending claims are in condition for allowance. The Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are made in order to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the capacity of the claims to particularly and distinctly point out the invention to those of skill in the art. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

1.   (Twice Amended)   A device for testing the operation of a modem in a computer, the device comprising:

a case;

a first communication port attached to the case and configured to be directly coupled to a modem in a computer thereby forming a primary communication link;

a second communication port coupled to the signal reporting circuit and configured to be coupled with the computer thereby forming a secondary communication link;

and

a signal reporting circuit located within the case and coupled to the first communication port and the second communication port, the signal reporting circuit including a microprocessor configured to send a signal to the computer via the secondary communication link to initiate the transmission of test data from the modem in the computer via the primary communication link and to evaluate the transmit capability of the modem in the computer over the primary communication link.

5.   (Amended)   A method of testing the operation of a modem in a computer using a portable modem testing device, the method comprising:

coupling the modem in the computer to the portable modem testing device;

coupling the computer to the portable modem testing device via an alternate communication link;

sending a signal from the portable modem testing device to the computer via the alternate communication link to initiate testing the operation of the modem in the computer;

initiating transmission of test data from the modem;

receiving the transmission from the modem at the portable modem testing device; and

verifying the transmission.

8.   (Amended)   A method of testing the operation of a modem in a computer using a [portable] modem testing device, the method comprising:

coupling the modem in the computer to the [portable] modem testing device;

coupling the computer to the [portable] modem testing device via an alternate communication link;

sending a signal to the computer via the alternate communication link to initialize the modem in the computer;

[initiating transmission] transmitting of test data from the [portable] modem testing device;

receiving the transmission from the [portable] modem testing device at the modem in the computer; [and]

verifying the transmission[.];

transmitting test data from the modem to the modem testing device;

verifying the test data.

11.   (Amended)   A method of testing the operation of a modem in a computer using a [portable] modem testing device, the method comprising:

coupling the modem in the computer to the [portable] modem testing device;

coupling the computer to the modem testing device via an alternate communication link;

initiating transmission of test data from the modem by sending a signal from the modem testing device over the alternate communication link;

receiving the transmission from the modem at the [portable] modem testing device;

verifying the transmission;

initiating transmission of test data from the [portable] modem testing device;

receiving the transmission from the [portable] modem testing device at the modem; and

verifying the transmission.